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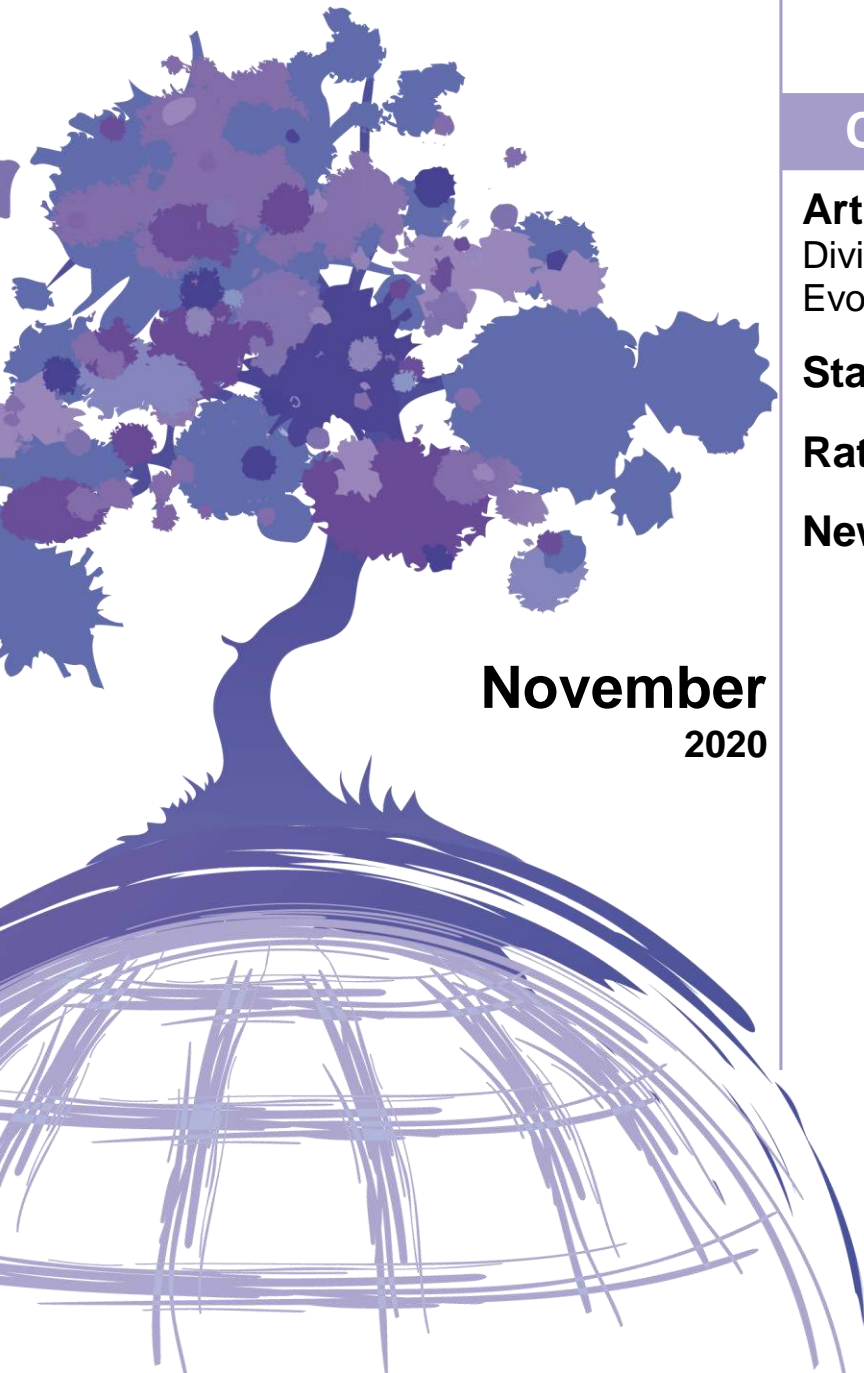
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Divisional Applications in India – Evolving jurisprudence

By Jaya Pandeya and Ankur Garg

In India, to file a divisional application, the parent (or main) application should include more than one invention. Section 16(1) of the Patents Act, 1970 ('Act') forms the legislative basis for filing divisional applications. As per Section 16¹, divisional applications may be filed whenever the parent application includes a plurality of distinct inventions. It is worth noting that under Section 10(5), the claims of a complete specification shall relate to a single invention or a group of inventions linked so as to form a single inventive concept. Thus, the presence of two distinct inventions in one application is a clear requirement for filing a divisional application.

¹ **Section 16. Power of Controller to make orders respecting division of application**

(1) - A person who has made an application for a patent under this Act may, at any time before the grant of the patent, if he so desires, or with a view to remedy the objection raised by the Controller on the ground that the claims of the complete specification relate to more than one invention, file a further application in respect of an invention disclosed in the provisional or complete specification already filed in respect of the first mentioned application.

(2). The further application under sub-section (1) shall be accompanied by a complete specification, but such complete specification shall not include any matter not in substance disclosed in the complete specification filed in pursuance of the first mentioned application.

(3). The Controller may require such amendment of the complete specification filed in pursuance of either the original or the further application as may be necessary to ensure that neither of the said complete specifications includes a claim for any matter claimed in the other.

Explanation—For the purposes of this Act, the further application and the complete specification accompanying it shall be deemed to have been filed on the date on which the first mentioned application had been filed, and the further application shall be proceeded with as a substantive application and be examined when the request for examination is filed within the prescribed period.

Moreover, Section 16(3) of the Act stipulates that none of the complete specifications (i.e., the parent application and the divisional application) should include claims for *any matter claimed in the other*. Thus, a divisional application to pursue similar claims, i.e., claims based on the same inventive concept is not allowed in India. In view of this requirement, the law relating to divisional applications is different from that of US and EP.

The Intellectual Property Appellate Board ('IPAB'), has interpreted the provisions relating to divisional applications and has shed light on the same. In the initial case law relating to divisional applications, it has been held that the existence of plurality of invention in the parent application is a *sine qua non* for a divisional application whether it is filed *suo moto* by the applicant or to remedy Controller's objection. Particularly relevant in this context is the order of the IPAB in the matter of *L.G. Electronics v. Controller of Patents* (2011)², that put to rest the issue of whether the filing of a divisional application by an applicant, if he so desires, can be interpreted to mean that an applicant can, on his own, file a divisional application even when claims in the specifications relate to only one invention.

Thus, while it was clarified that the interpretation of 'if he so desires' is subject to the condition that the parent application contains more than one distinct invention, certain other issues relating to divisional applications, such as: (i) whether claims of a divisional application can

² OA/6/2010/PT/KOL

be based on the **disclosure** of the parent application or do they have to be based on the **claims** of the parent application; (ii) whether a divisional of divisional is allowable; and (iii) how to assess if the claims of a complete specification relate to distinct inventions, i.e., lacks unity of invention, remained unclear. However, recent orders from the IPAB, have now adjudicated on aspects pertaining to eligibility of divisional application and have thrown some light into some of these issues that are discussed herein.

Whether claims of a divisional application can be based on the disclosure of the parent application

The recent orders of the IPAB in the cases *Procter & Gamble Company v. The Controller of Patents & Designs*³; *Esco Corporation v. The Controller of Patents & Designs*⁴; and *UCB Pharma S.A. v. The Controller of Patents & Designs*⁵, leave little to doubt as to whether claims of a divisional application can be based on the disclosure of the parent application or they necessarily have to be a part of the subject matter claimed in the parent application.

The IPAB has held that the patent application can only be divided, if it **claims** more than 'one invention'. The IPAB reasoned that "A plain reading of sub-section (1) of section 16 reveals that the very ground to accept divisional application is "on the ground that the **claims of the complete specification** relate to more than one inventions. Sections 10(5) further qualifies "more than one invention" to only such invention or group thereof which cannot be linked to make a single inventive concept". Negating the contention that some additional claim(s) can also be allowed, which never formed part of the originally filed claims, the Appellate Board

clarified that claims of a divisional applications have to be based on claims of the parent and not its disclosure/specification. It is thus held that the claims of divisional application shall have their root in the claims of the parent application.

Also, relying on the *L.G. Electronics* case, the IPAB reiterated that the divisional application shall not be filed with the same set of claims as the first mentioned application.

It will be interesting to see how the patent office devises an objective test to assess if the claims of divisional application have their root in the claims of the parent application. The presently prevalent practice of assessment followed by the controllers at the patent office, that involves a clinical comparison of words of the claims of the divisional and the parent application, may often be ineffective to serve to true intent of the law.

Whether a divisional of divisional is allowable

In the context of Section 16 of the Act, another issue that stems up is, whether Section 16 allows filing of a divisional application of a divisional application. That is to say, after the filing of a divisional application arising from a parent application, can a further divisional application arising from the first filed divisional application be filed before the grant of said first filed divisional application but after the grant of the parent application?

Based on a plain reading of Section 16, it is gathered that a divisional of a divisional application is not prohibited. This is because Explanation to Section 16 clearly states that after the first divisional is filed, said application is to be treated as a substantive and independent application which means it can become an initial application for filing of a further divisional application, provided the condition of plurality of

³ OA/47/2020/PT/DEL

⁴ OA/66/2020/PT/DEL

⁵ OA/3/2015/PT/MUM

invention is satisfied in the first divisional application. However, based on numerous Controller's orders, it is clear that while multiple divisional applications filed from a parent application are found allowable by the patent office, a divisional application arising from a previously filed divisional application is not.

This issue was resolved, to a certain extent, by the order of the IPAB in the case of *National Institute of Immunology v. The Assistant Controller of Patents & Designs*⁶ and *Milliken & Company v. Union of India and others*⁷. However, in these cases the further divisional application was found allowable because the Controller, in the first examination report (FER) of the further divisional application, had raised objections relating to the lack of unity of invention. To this extent, these orders did not settle the question about validity of such divisional applications unambiguously.

The recent order of the IPAB in the case of *Esco Corporation v. The Controller of Patents & Designs*, has held that filing of a divisional application arising out of a divisional application is allowable, provided that the above-mentioned condition is true for the divisional of a divisional as well, i.e., the claims of the divisional of divisional find its roots in the claims of the divisional application. Needless to mention, the divisional of a divisional application is subject to other conditions, such as presence of multiplicity of inventions and pendency of the first divisional application. Thus, the present order puts to rest the long-standing ambiguity and clarifies that a divisional of a divisional application is not invalid solely for the reason that it is carved from a previously filed divisional application.

⁶ IPAB Order No. 83 of 2015 dated 25th Mar, 2015

⁷ IPAB Order No. 17 of 2016 dated 2nd Mar, 2016

How to assess if the claims of a complete specification relate to distinct inventions / lacks unity of invention

It is now an established principle of law that to file a divisional application, there must exist plurality of inventions in the parent application. Provided there are plurality of inventions in the parent application, either the applicant may file a divisional application on his own accord, or may decide to file the divisional application based on an objection raised by the Controller for lack of unity of invention in the parent application.

More often than not, in situations where a divisional application has been filed, either *suo moto* by the applicant, or based on an objection raised by the Controller, a Controller is likely to object that the divisional application is not valid, either based on the fact that parent application did not include plurality of inventions, or the claims of the divisional application fall within the scope of the parent application, and the divisional application ought not to have been filed in the first place. Therefore, there has been a long felt need as to how to correctly determine if an application indeed includes plurality of inventions for which an applicant can correctly file a divisional application.

In the *Esco Corporation* case, the IPAB has looked at the provisions of unity of invention in the Patents Act, 1970 and the rules of Patent Cooperation Treaty (PCT) to identify the manner in which determination of unity of invention should be made.

The Appellate Board observed that the basic premise for filing any divisional application is based on the requirement of Section 7⁸ of the

⁸ Section 7 Form of application:

(1) Every application for a patent shall be for one invention only and shall be made in the prescribed form and filed in the patent office.

Patents Act, which mandates that every patent application should be filed only for one invention. Further, based on the interpretation of Section 10(5) of the Patents Act, 1970, which requires the claim or claims of a complete specification to relate either to a single invention, or a group of inventions linked so as to form a single inventive concept, the IPAB observed that no two inventions can be allowed in a single patent application, unless it conforms to a single inventive concept. Hence, the Board observed that either way, it is a single inventive concept which is allowable in one application, as per the statutory provisions of the Patents Act, 1970.

The IPAB, also relied on Rule 13 of PCT, which specifies that the requirement of unity of invention for a group of inventions claimed in an international application is fulfilled when there is a technical relationship among those inventions involving one or more special technical features, wherein the technical features define a contribution which each of the claimed inventions makes over the prior art, to establish the principle of 'One Application One Inventive Concept (OAOIC)', which is allowable in a single application.

Although IPAB has not provided any clear guideline for determining the presence of a single inventive concept in claims of an application, their reliance on Rule 13 of PCT is indicative of the fact that if there is no technical relationship among the inventions claimed in an application, the claims of the application would lack 'unity of invention'. However, the IPAB has also cautioned that by the presence of different embodiments in the specification, which are claimed as independent set of claims, it should not be

asserted that the application lacks 'unity of invention'.

Thus, it is clear from the observations of the IPAB that based on determination of presence or absence of single inventive concept amongst claims of an application, it should be determined if the application has unity of invention, and accordingly determination should be made if a divisional application should be filed or not.

While the absence of single inventive concept in claims of an application allows an applicant to file a divisional application, the IPAB has also observed that in cases where the application does not lack single inventive concept, but the Controller has raised an objection of lack of unity of invention, the applicant should not be left without a remedy and, any divisional filed in pursuance of Controller's objection, should not be disallowed.

Conclusion

As the law continues to evolve, applicants remain desirous of consistent practices being adopted by the Controllers to assess validity of their divisional applications. Owing to different practices adopted by applicants and the patent office, in the interest of justice and for the sake of uniformity of practice, the IPAB has laid down guiding principles to address this issue in the *Esco Corporation*. We look forward to these guiding principles being put into practice by the patent office by amending the guidelines for examinations of divisional applications.

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Statute Update

Patents – Fees payable by a small entity reduced – Patent Rules amended to bring small entities at par with start-ups

The Department for Promotion of Industry and Internal Trade under the Ministry of Commerce and Industry has on 4 November 2020 issued Notification No. G.S.R. 689(E) to notify the Patents (2nd Amendment) Rules, 2020 making certain changes in the Patents Rules, 2003 to bring small entities at par with start-ups.

Fees payable by a small entity has been reduced and brought at par with what is payable by a natural person or a start-up. The reduction applies to both modes of filing applications – e-filing and physical filing. Rule 7(3) and Table I of the 1st Schedule to the Patents Rules, 2003 have been amended to club a natural person, start-up and small entity under one bracket in respect of the fees payable under Section 142 of the Patents Act, 1970 and in respect of other matters for which fees is required to be paid under the Patents Act. It may be noted that the latest provisions, effective from 4 November 2020, reiterate the earlier provisions in respect of situations where an application processed by a natural person or start-up or small entity is fully or partly transferred to a person other than a natural person, start-up or small entity.

Further, an Explanation has been inserted to state that in case a small entity ceases to be a ‘small entity’ due to increase in its turnover, etc., the difference in scale of fees (between what is payable by a small entity and that payable by other entity) is not payable. Identical provisions

which were earlier available only in respect of start-ups, have been retained. Similarly, small entities have also been brought at par with start-ups in respect of requests for expedited examination of applications. Proviso to Rule 24C(5) has been amended for this purpose.

Patents – Filing of priority documents and statements – Patents Rules amended

Patents Rules, 2003 have been amended with effect from 19 October 2020 to make certain changes in Rules 21 and 131. Further, Form 27 has also been substituted by Notification G.S.R. 652(E) issued by Department for Promotion of Industry and Internal Trade in the Ministry of Commerce and Industry.

While the new substituted Rule 21 now makes additional reference to certain Regulations under the Patent Cooperation Treaty (PCT), Rule 131 has been amended to increase the time limit for filing Form 27 under Section 146(2) of the Patents Act, 1970. The Form pertains to ‘statement regarding the working of patented invention(s) on a commercial scale in India’ and is now supposed to be filed annually within 6 months from the date of expiry of the financial year. According to the provisions hitherto in application, the statement was required to be furnished, in respect of every calendar year, within three months of end of each year.

Further, in a major development towards reduction of compliance burden, the new Form 27 provides that one form may be filed in respect of multiple patents, provided all of them are related patents, wherein the approximate

revenue / value accrued from a particular patented invention cannot be derived separately from the approximate revenue/value accrued from related patents, and all such patents are granted to the same patentee. It may also be

noted that according to the new Form, only 'approximate' revenue / value accrued in India to the patentee/ licensee furnishing the statement is now required.



Ratio decidendi

Mere addition of prefix/suffix to a trademark is of no consequence when marks deceptively similar

In a case involving application for an interim injunction to restrain the defendants from adopting or using the trade mark/title 'NEWS HOUR', the Delhi High Court has passed an interim injunction against the defendants restraining them from using the said mark or any other mark which is deceptively similar to the plaintiff's mark. The Court however, declined to pass any interim order against the defendant in respect of the trademark/title/tagline 'NATION WANTS TO KNOW'.

Relying upon Court's earlier decision in the case of *Procter & Gamble Manufacturing (Tianjin) Co. Ltd. v. Anchor Health & Beauty Care Pvt. Ltd.*, the High Court rejected the defendant's plea that the mark 'NEWS HOUR' was generic and incapable of being protected as a trademark. It observed that the mark was not *prima facie* considered by the authorities having expertise in the matter as being descriptive of the goods, etc. or incapable of distinguishing the goods or services of one from another, at the time of registration. It also noted that there were no

objections then on the ground of applicability of Section 9 of the Trademarks Act and that the defendant had not yet challenged the registration of the said mark. Plea that the mark was being used by the defendant with prefixes or suffixes, was also rejected by the Court while it held that merely adding some prefixes or suffixes to the trademark 'NEWS HOUR' does not help the claim that the defendant's mark was not deceptively similar to that of the plaintiff. The marks ARNAB GOSWAMI's NEWSHOUR, ARNAB GOSWAMI's NEWSHOUR 9, etc. were held to be *prima facie* deceptively similar to the mark of the plaintiff NEWS HOUR.

Declining to grant interim relief in respect of 'NATION WANTS TO KNOW', the Court observed that the documents required a detailed examination. It noted that the plaintiff had earlier filed the application in the Trademark Registry as 'proposed to be used' and hence the date of user of the tagline can only be decided appropriately after the parties have led their evidence. [*Bennett Coleman and Company Ltd. v. ARG Outlier Media Pvt. Ltd. and Others* – Judgement dated 23 October 2020 in CS(COMM) 434/2017, Delhi High Court]

Patents – Pre-grant opposition not maintainable after Controller disposes patent application

The Bombay High Court has upheld the IPAB Order which had held that pre-grant application cannot be filed when Controller has disposed of the proceedings for grant of the patent. The Court rejected the Petitioner's contentions that the Appellate Board had wrongly directed the Controller to grant the patent even though it knew of the existence of pre-grant opposition. The petitioner had filed a pre-grant opposition after the conclusion of hearing by the IPAB but before the IPAB pronounced its order.

The Court observed that the right of pre-grant opposition under Section 25(1) of the Patents Act, 1970 continues only till the matter is decided by the Controller and not further. The contention that appeal to IPAB was a continuation of proceedings was held as not correct, as the proceedings are not akin to a civil suit between plaintiff and a defendant. It was held that the Controller had become *functus officio* in respect of such application since there was no patent application pending before him at that time.

The plea that the pre-grant opposition can be filed before the patent is sealed as provided under Section 43 of the Patents Act, 1970, was also rejected by the Court as it held that the interpretation will lead to anomalous situation. It observed that under Section 117-D(2) when a certified copy of the Order passed by the IPAB is communicated to the Controller, the latter is duty bound to give effect to the former's Order and only ministerial act remains. The Court was of the view that if after the Order of the Appellate Board, the Controller entertains pre-grant applications, it may give rise to an endless series of oppositions and will do violence to the scheme of the Patents Act.

The High Court also noted that once the appeal is kept for pronouncement of reasons, application to the effect that order should not be pronounced cannot be entertained. Dismissing the petition with costs, the Court also observed that there was serious doubt about the credentials of the Petitioner. [*Dhaval Diyora v. Union of India – Judgement dated 5 November 2020 in Writ Petition (L) No. 3718 of 2020, Delhi High Court*]

'Delhivery' is a phonetically generic word relating to 'delivery'

The Delhi High Court has vacated the interim injunction granted in favour of the plaintiff in a suit for infringement and passing-off of the mark 'Delhivery' by the mark 'Deliver-E'. The Court was of the view that the mark 'Delhivery' was *prima facie* a phonetically generic word and could not be registered to seek benefit of the statutory rights. The Court noted that while the mark 'Delhivery' was a coined mark, a combination of 'Delhi' and 'Very', and according to the plaintiff, was different from the generic word 'delivery', the plaintiff had submitted that the mark 'Deliver-E' was deceptively similar to the plaintiff's mark and thus had attempted to relate the mark 'Delhivery' with the generic mark 'delivery'.

The Court also noted that *prima facie* there could not be any comparison as the origin of the marks were different, there was no similarity between the marks and that the mark of the defendant was structurally / visually at variance with the mark of the plaintiff. According to the Court, the mark 'Delhivery' is immediately connectable to the delivery services and cannot be termed as a suggestive mark. It further noted that it was the conceded case of the parties that the clientele of both the parties were companies which surely could differentiate between the marks of the plaintiff and defendant. The High Court also held that the use of the mark since 2011 and high sale figures were not conclusive to hold that the mark had attained distinctiveness. [*Delhivery Private*

Limited v. Treasure Vase Ventures Private Limited – Judgement dated 12 October 2020 in CS(COMM) 217/2020, Delhi High Court]

Patent infringement suit in India – Anti-suit injunction order by foreign court when not enforceable

The Delhi High Court has held that defendant in a suit being prosecuted in India cannot be allowed to employ the order of the Court, passed outside the territory of India, as a means to non-suit the plaintiff who had instituted a plaint which according to Indian law was capable of being maintained and prosecuted. The High Court allowed the plaintiff's application for restraining the defendant from pursuing or enforcing the anti-suit injunction order passed by the Wuhan Intermediate People's Court in a Standard Essential Patent (SEP) royalty rate-setting suit, between the same parties, before the said foreign court. The Indian suit before the Delhi High Court involved alleged infringement of certain patents of the plaintiff in India.

The Delhi High Court observed that there is no law, in this country, which can restrain the parties from prosecuting a proceeding, which has been preferred before a judicial forum, and nor can any Court, in India, compel a party to withdraw or 'suspend' a proceeding, once filed. Granting injunctions against the enforcement of an order passed by a foreign Court, the Court noted that the manner in which the defendant had 'obtained' the Wuhan Court's Order was disturbing as there was a clear intent to keep the plaintiff unaware of the exact specifics of the litigation preferred by the defendants against the plaintiff in China, and that the same was not even disclosed to the Delhi High Court.

Observing that it was not open to any Court to pass an order, prohibiting a Court in another country to exercise jurisdiction lawfully vested in it, the High Court held that any such decision

would amount to a negation of jurisdiction, which cannot be countenanced. The Court also noted that if the Wuhan Court's Order is implemented/enforced, the issue of infringement would remain permanently unaddressed by any forum and the right of the plaintiffs to seek protection of the SEPs held by them would also be irrevocably foreclosed. [*Interdigital Technology Corporation & Ors. v. Xiaomi Corporation & Ors.* – Order dated 9 October 2020 in I.A. 8772/2020 in CS(COMM) 295/2020, Delhi High Court]

Patent revocation – Prior claim, inventive step and disclosure

The Delhi High Court has declined to grant interim injunction in a case involving alleged infringement of the patent involving a compound Dapagliflozin. The Court found that the defendants' submission that plaintiff's IN 625 (species patent) should be revoked on account of prior claiming under the provisions of Section 64(1)(a) of the Patents Act, 1970 had substance, at the preliminary injunction stage. It noted that there was a definitive assertion that Dapagliflozin, the compound-in-issue, was covered in both the genus patents granted in USA and India i.e. US 126 and IN 147. The plea of the plaintiff that the compound was not disclosed in IN 147 was rejected by the Court noting that the plaintiff had taken out an infringement action both for IN 147 and IN 625 and that it was incongruous that a patent holder can take out an infringement action for a patent and yet aver that it was not disclosed. It was held that if the defendant can establish that the invention so far as claimed in any claim of the complete specification [IN 625] was claimed in a valid claim of an earlier priority date contained in the complete specification of another patent [IN 147] – a ground for revocation is made out.

On the ground of technical advancement or inventive step, the Court was of the view that post priority date evidence, furnished to show technical advancement, can only confirm the existence of technical effect which is found in the specification of IN 625 and is capable of being understood by a skilled person having common general knowledge and not to rely upon the same to establish its effect for the first time. Plaintiff's contention that the examiner should have been conscious of the inventive step objection was dismissed by the Court observing that the defendants were entitled to raise the same in defence to an infringement action. The Court also observed that plaintiff had not furnished the examination report issued by the USPTO *qua* US species patent 117 and had not placed before Indian Patent Office the fact that the validity

period of US 117 was voluntarily aligned with the US genus patent i.e. US 126.

The Court also rejected the argument advanced by the plaintiffs that since the suit patents are old, they should thus be presumed to be valid. The Court observed that Section 107 of the Patents Act, 1970 expressly confers a right on the defendants to raise, in defence, in an infringement suit, all those grounds on which the patent can be revoked under Section 64. It noted that the presumption of validity exists only till such time the patent is challenged - a challenge which is credible and no further. The Court also held against the plaintiff on balance of convenience and on irreparable damages. [*Astrazeneca AB & Anr v. Intas Pharmaceuticals Limited* – Judgement dated 2 November 2020 in I.A. No. 8826/2020 in CS (COMM) No. 410/2020, Delhi High Court]



News Nuggets

No global damages for infringement of a UK Standard Essential Patent

The United Kingdom's High Court of Justice, Business and Property Courts of England and Wales has held that damages for infringement of a UK Standard Essential Patent should not be calculated by reference to sales of goods outside the UK. The Court was of the view that the foreign sales were not caused by an act of infringement of a UK patent. The dispute involved certain patents in mobile devices. The petitioner was of the view that it had lost revenue

which it could have earned pursuant to the licence, and that revenue would have been paid regardless of the country in which the phones would have been sold. Observing that the plea will amount to claiming damages for infringement of foreign patents, the Court in the case *IPCOM GmbH & Co. KG v. HTC Europe Co. Ltd.* [Judgement dated 4 November 2020] held that there was no claim for infringement of foreign patents in the case and that there was no basis for making such a claim by the back door.

Copyrights in trade dress of 'Monaco', 'Krackjack' and 'Hide & Seek' biscuits – Interim relief against 'CrackO', 'Cracker King' and 'Peek-a-Boo'

The Bombay High Court has held that the labels / artworks / packaging / trade dresses of the Defendants' 'CrackO', 'Cracker King' and 'Peek-a-Boo' products are a reproduction of the Plaintiffs' packaging used in respect of their 'MONACO', 'KRACKJACK' and 'HIDE & SEEK' products and / or reproductions of substantial parts thereof. Comparing the trade dress, the Court was of the view that the similarity in the rival packaging/labels cannot be a matter of coincidence. Granting ad interim relief, the Court in the case *Parle Products Pvt. Ltd. v. Future Consumer Ltd.* [Order dated 9 October 2020] noted that *prima facie*, the Plaintiffs were the owners of the copyright in Plaintiffs' packaging used in respect of their 'MONACO', 'KRACKJACK' and 'HIDE & SEEK' products and had acquired substantial goodwill and reputation in the same.

Trademarks – Territorial jurisdiction of High Court – Place where defendant markets its product

The Madras High Court has held that the cause of action for passing off arises only at the places where the defendant markets the products. Dismissing the suit for permanent injunction restraining the defendants from infringing the Trademark or for permanent injunction restraining the defendants from passing off the products, the Court observed that the defendant was not marketing its products within the jurisdiction of the Madras High Court. The Court observed that though

Section 134 of the Trademarks Act grants an additional place to institute the suit but that cannot be taken as permitting expanding the place where the cause of action arose. The High Court in the case *Ashique Exports (P) Ltd. v. Suresh K.K.* [Judgement dated 4 November 2020] was of the view that the issue of passing off can never be decided when the Court lacks territorial jurisdiction. It also noted that the plaintiff had not obtained any leave to combine the causes of action under Clause 12 of the Letters Patent. Even the witness for the plaintiff had admitted that the defendants are not marketing their products at Chennai but are marketing their products only in Kerala.

However, it be noted that the primary reason for the suit being dismissed, after trial, was that admissible proof was required to establish the fact that the Plaintiff had a registration with a prior date. But, the plaintiff had failed to produce admissible evidence.

Patents – No discretion with Controller to refuse a case without hearing

The IPAB has held that while the Controller does have discretionary power to allow or not to allow the request for adjournment filed under Rule 129A of the Patents Rules 2003, he does not have any discretion to refuse a case without giving a fair opportunity of being heard to the applicant. Relying on Section 80 of the Patents Act, 1970, Rule 129 of the Rules and principles of natural justice, the Appellate Board in the case *Lifesaver IP Limited v. Assistant Controller* [Order dated 12 October 2020] was of the view that the legal provisions do not allow the Controller to decide the matter against the applicant, without giving him an opportunity of being heard.

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